

## REMARKS

The objections to claims 1 and 21 are attended to above as courteously suggested in the Action. Claim 1 is also presented in Jepson or improvement form to confirm the inclusion of the preamble by the prior reference to its terms in the body of the claim.

The rejections of independent claims 1, 7 and 21 under 35 USC 102 for anticipation by the cited Cobben, et al. patent and, even less so, those of dependent claims 3 and 4 as well as the other dependent claims cannot be sustained.

A claim is anticipated only if each and every element AS set forth in the claim is found, either expressly or inherently described ... in AS complete detail AS is contained in the ... claim. *MPEP* 2131 (citations omitted) (emphasis added).

The independent claims require deriving authenticity from viewing non-perpendicularly perpendicular perforations. Cobben, et al. describes at col. 4, lines 25-29, for Fig. 4 deriving authenticity (e.g., logo viewing) only from viewing non-perpendicularly NON-perpendicular (i.e., oblique) perforations.

The Action cites col. 3, lines 17-24, of the Cobben et al. patent for deriving authenticity from optical transmission in a viewing, but the claimed viewing has to be non-perpendicular while this portion of the patent is silent about this. To overcome this weakness in the rejection, the Action cites col. 5, lines 25-27, i.e. claim 6, for an image that varies with angle of view. However, for this, col. 4, lines 25-29, of the patent requires oblique perforations, whereas the claim requires perpendicular ones. Therefore, the complete detail of every element AS in the independent claims cannot be found in the Cobben, et al. patent.

While the rejection cannot be sustained under 35 USC 102, because every element AS set forth in the claims cannot be found in the Cobben, et al. patent, it may yet be thought that the claims are obvious from the patent, but this is not the case, because even the Action, as intimated above, cannot find a rational underpinning for combining its teachings in the way taught only by the application.

... [R]ejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, Fed. Reg. October 10, 2007, 57526, 57528-9.

Claim 1 requires the carrier to have perforations perpendicular to a surface of the carrier with elongate cross section for authentication by viewing non-perpendicularly. In other words, claim 1 unmistakably requests that the transmission of *elongate* perforations that *extend perpendicularly through the document* is checked under an oblique viewing angle and that this transmission is used for deriving the authenticity, i.e. elongate, perpendicular perforations are used in the claimed procedure.

In contrast to this, in Cobben, et al, the *non-perpendicular, non-elongate* holes are used to derive the authenticity by viewing them non-perpendicularly (col. 4, lines 6-8). Nothing in Cobben, et al. suggests that the perpendicular holes could be used for such a procedure.

The Examiner asserts that we argued that the Cobben invention teaches only perforations "which extend non-perpendicularly through the carrier". It is not true that we have argued in this manner. Cobben, et al. so show holes that extend perpendicularly through the carrier. However, for verifying the authenticity by viewing under an oblique angle, Cobben, et al. use the non-perpendicular, non-elongate holes. Cobben, et al. did not recognize

that elongate, perpendicular holes can also be used for the same purpose.

As to claims 3 and 4 the effect the invention is based on - namely becomes strongest when viewing the holes from the directions claimed in claims 3 and 4.

As far as we can glean from the action, it appears that the Examiner rejected these claims as anticipated by Cobben, et al. by stating that the "document may inherently be viewed at any angle". We doubt that this statement is sufficient for rejecting the claims, even under U. S. practice. According to MPEP 2143.01 IV, the mere fact that a modification was possible does not render a claim obvious. Rather, "there must be a suggestion or motivation in the reference to do so", MPEP 2143.01 III. Cobben, et al. do not teach that the direction - dependent transmission characteristics of elongate, perpendicular holes could be used for verifying the authenticity, and therefore there is no motivation for the person skilled in the art for viewing the elongate, perpendicular holes in the manner claimed by claims 3 or 4.

As to claims 7 and 20, the combination of features in these claims (perpendicular, elongate holes, different cross section but equal area) make the different types of holes indistinguishable when orthogonally viewing the carrier, but generate a difference when obliquely viewing the carrier.

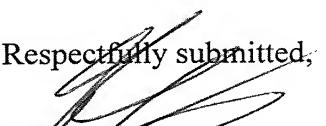
The combination of these features is not disclosed by Cobben, et al.. In particular, Cobben, et al. do not teach to use elongate, perpendicular holes with differing cross sections but equal area.

- Regarding the feature "cross section have equal area", the examiner refers to "figures 3 and 4". However, Fig. 3 does not show perpendicular holes, and there is no indication that the perpendicular holes of Fig. 4 are elongate.
  
- Regarding the feature "different cross sections" the Examiner refers to col. 4,

lines 10-15 and 44-47. However, lines 10-15 refer to an embodiment (fig. 2) that has oblique holes, and describe that different hole diameters have the purpose of modulating the gray tones, which implies that the areas of the holes are varied (in contrast to the claim). Lines 44-47 say that holes of different cross sections can be created, but do not suggest in any way that the cross sections should have equal area as claimed.

Reconsideration and allowance are, therefore, requested.

Respectfully submitted,

  
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